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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,283	03/10/2000	Robert M. Miller	10001063-1	6010

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EXAMINER


MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/523,283	Applicant(s) MILLER ET AL. 	
	Examiner James W Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-29 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-29, and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on April 19, 2004 under 37 CFR 1.111 has been considered but is ineffective to overcome the Donohue et al (5,987,480), Rapaport et al (5,890,152) and Griebenow et al (5,850,520) references. The amendment canceled Claims 14, 30, and 31 and amended claims 1, 15, 24, 32, and 34. Therefore, the currently pending claims considered below are Claims 1-13, 15-29, and 32-37.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-6, 10, 11, 13, 15, 16, 19, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Donohue et al(5,987,480).

Claims 1, 15, and 32: Donohue discloses a system, method, and device for delivering a customized document, comprising:

- a. storing a plurality of content objects (col 7, lines 35-47 and col 8, lines 10-13); and
- b. selectively retrieving one or more of the content objects to construct a customized document based on a user profile (col 4, lines 16-34; col 5, lines 63-67; and col 11, lines 21-25).

Claim 2: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses that the user profile includes information regarding the user's interests (col 10, lines 20-23).

Claim 3: Donohue discloses a system for delivering a document as in Claim 2 above, and further discloses acquiring the user profile using both covert and overt processes (col 10, lines 20-23 and 43-48).

Claims 4, 5, and 13: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses constructing the document based on information from a personal profile (user profile) and one or more key contributors, which the Applicant has defined in Claim 5 as the user's interests, demographics, seasonality,

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document server requirements, and content provider usage criteria (col 10, lines 20-23 and 43-48; and col 11, lines 21-25). The Examiner notes that the key contributor examples are the same type of information included in the user profile as claimed in Claim 2 above.

Claim 6: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses receiving and storing the content objects and then retrieving one or more content object to generate the personalized (customized) document (col 7, lines 35-47).

Claims 10, 11, and 16: Donohue discloses a system and method for delivering a document as in Claims 1, 6, and 15 above, and further discloses retrieving the content objects based on information from the user profile and one or more key contributors as discussed in the rejection of Claim 4 and 5 above (col 10, lines 20-23 and 43-48; and col 11, lines 21-25).

Claim 19: Donohue discloses a method for delivering a document as in Claim 16 above, and further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 12, 17, 18, 24, 25, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480).

Claims 7, 24, and 34: Donohue discloses a system, method, and device for delivering a document as in Claims 6, 15, and 32 above, but does not explicitly disclose using a non-invasive marking wrapper to uniquely identify and distribute the document. Official Notice is taken that it is old and well known to use wrappers to protect and to distribute documents, such as newspapers and magazines, and to place unique identifying indicia onto the wrapper (e.g. names and address of subscriber) to facilitate the distribution of the document. For example, the National Geographic magazine is distributed using a plain brown wrapper upon which the subscriber's name and address is printed, along with text and graphics identifying the publication and other information. The Examiner has been receiving this magazine wrapped in this manner for approximately 8 years. Furthermore, an electronic document sent to a subscriber is usually encapsulated in an email message that not only identifies the subscriber and distribution data (email address), but also includes a title or subject line to identify the document enclosed or attached to the email message. Another well-known feature that

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email services provide is a "return receipt" option in which the sender may select to receive notification when the recipient has received (and/or opened) the email as discussed by Rapaport (see the rejection of Claims 8, 20, 22, 26, 27, and 35 below). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to wrap the document in Donohue in a non-invasive marking wrapper which uniquely identifies the document and which can be used to distribute the document and then to use the well-known return receipt feature of email systems to track the user's receipt and disposition of the document. One would have been motivated to use such a wrapper and tracking steps in view of Donohue's disclosure that the system will receive and store the user's Internet address and email address (col 10, lines 20-23 and 31-34) and then use such information to deliver a customized document to that user.

Claims 12, 17, and 18: Donohue discloses a system and method for delivering a document as in Claims 11 and 16 above, but does not explicitly disclose the content provider limiting the publishing of their content based on the publishing of content from another content provider, such as a competitor. Official Notice is taken that it is old and well known within the marketing arts for content providers to place limitations on when, how, and where their content can be published. One of the well known limitations is the proximity to other similar or competing content. For example, an advertiser for an alcohol product would not desire the advertisement to be published with an article directed towards the problems of drunk driving; nor would a tobacco producer want to

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advertise their product next to an article about the detrimental effects of cigarette smoke. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the content provider to place limitations as to the publishing of their content in respect to other content objects or competitors' content objects. One would have been motivated to allow such limitations in order to prevent conflicting content of being published together.

Claim 25: Donohue discloses a method for delivering a document as in Claim 24 above, and further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34).

Claim 33: Donohue discloses a system and device for delivering a document as in Claim 32 above, and further discloses constructing the document based on information from a personal profile (user profile) and one or more key contributors as discussed in reference to Claims 4, 5, and 13 above. While it is not explicitly disclosed that the user profile or key contributors include one or more of a season of publication, a geographic location of the requesting user, the document server features or limitations, or the content provider usage criteria, it would have been obvious to include at least the geographic location of the requesting user as part of the user demographics in the user's profile. It also would have been obvious to use the current time of the year (i.e. season) to determine the desirability of the content object, such as presenting a content object about ski resorts during the winter instead of during the spring or summer. As

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discussed above in reference to Claims 12, 17, and 18, it would have also been obvious to taken into account any limitations or usage (targeting) criteria designated by the content provider, such as distributing an advertising content object only between the start and end dates of a promotional campaign as indicated by the content provider. One would have been motivated to use one or more of these criteria when compiling the document to distribute in order to provide a document which is more pertinent to the user.

6. Claims 8, 20-22, 26, 27, 29, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152).

Claims: 8, 20, 22, 26, 27, and 35: Donohue discloses a system, method, and device for delivering a document as in Claims 7, 19, 25, and 34 above, but does not explicitly disclose virtual sensors that will identify and report to the content manager information about the distribution, receipt, and user disposition of content objects. Rapaport discloses a similar system, method, and device for delivering a document (media file) over the Internet, and further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing "how long the user is looking at the section of the media file segment, if the sound file/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to" (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor and report the

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distribution, receipt and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more meaningful updates to the user's profile by determining if the content objects is of interest to the user as discussed by both references.

Claims 21, 29, and 36: Donohue and Rapaport disclose a system, method, and device for delivering a document as in Claims 20, 26, and 35 above, and both references disclose updating the user profile based on the received information (Donohue, col 7, line 49 – col 8, line 8)(Rapaport, col 2, lines 55-62).

7. Claims 9, 23, 28, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152) as applied to claims 8, 20, 26, and 35 above, and further in view of Griebenow et al (5,850,520).

Claims 9, 23, 28, and 37: Donohue and Rapaport disclose a system, method, and device for delivering a document as in Claims 8, 20, 26, and 35 above, but neither reference explicitly discloses initiating a financial transaction between the content manager and one or more of the content providers based on the collected monitoring data. Griebenow discloses a similar system, method, and device for delivering a document over the Internet which also discloses the content manager (publisher) initiating a financial transaction (charging) with a content provider (advertiser)(col 9, lines 47-48; col 10, lines 6-10 and 25-27). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to initiate financial transactions between the content manager and one or more content providers. One would have been motivated to conduct such financial transactions in order to make the system financially viable by allowing the content manager to be paid by advertising content providers for inclusion of their advertisements as in common in the publishing industry.

Response to Arguments

8. Applicant's arguments filed April 19, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claims 1, 15, and 32 that Donohue does not disclose a system "to selectively retrieve the plurality of the received content objects to construct a customized publication...based, at least in part, on a user profile" (page 8). The Examiner notes that Donohue explicitly discloses that the selected template is populated with content objects selected from the content object database (col 7, line 35 – col 8, line 9) to generate a document (publication) "which is specific to the user's interests or which provides the user with customized information regarding the user's relationship with the web site manager" (col 11, lines 21-25). Thus, while Donohue is selecting the appropriate template which can be viewed on the user's particular browser as argued by the Applicant, it is also disclosed that this template is used to construct a customized document by selecting and incorporating content objects based on the user's profile.

b. The Applicant again argues in reference to Claims 7, 12, 18, 24, 25, 33, and 34 that Donohue does not disclose a system “to selectively retrieve the plurality of the received content objects to construct a customized publication...based, at least in part, on a user profile” (pages 9-10). The Examiner refers the Applicant to the response to this argument in the preceding paragraph.

c. The Applicant argues in reference to the Official Notice taken in the rejection of Claims 7, 24, and 34 (page 10) that it is not old and well known for a wrapper “to identify distribution, receipt and user disposition of the content object throughout the distribution system”. The Examiner notes, however, that the rejection gave two examples of well known “wrappers” – the “plain brown wrapper” and an electronic wrapper (e.g. email). The Examiner agrees that a plain brown wrapper (paper) could be used to identify the distribution and possibly receipt (through a return receipt from the United States Post Office), but could not be used to identify the disposition of the content by the user. Once the user has received the document (via postal mail), the outside wrapper is usually discarded. However, in the electronic wrapper example given in the rejection above, it is discussed how one of the usual features offered by email providers is a tracking system which can tell the sender when the recipient has received (receipt) and opened (disposition) the wrapper (email). Rapaport also discusses this feature as discussed in the above rejection.

d. The Applicant argues in reference to the Official Notice taken in the rejection of Claims 12, 17, and 18 that it is not old and well known to publish “select content objects from one content provider with respect to content objects from another content

provider” and gives an example of a beer company including the words “drink responsibly” on its label or a cigarette package being marked with warning about the danger of tobacco (page 11). The Examiner notes that the Applicant’s examples have nothing to do with the subject matter of the Official Notice. The Official Notice says that it is old and well known for a content provider to place limitations on when and where his content object is to be published. As in the examples given, it is common for an advertiser for an alcohol product to not place an alcohol advertisement next to an article about drunk driving; a tobacco company not to place a cigarette advertisement next to an article about lung cancer; the Catholic Church not to place its article next to a birth control advertisement; etc. This has nothing to do with what is printing on a label of a product as argued by the Applicant, but is directed towards selecting content objects to be published together in one publication.

e. The Applicant again argues in reference to Claims 8, 20-22, 26, 27, 29, 35, and 36 that neither Donohue nor Rapaport disclose a system “to selectively retrieve the plurality of the received content objects to construct a customized publication...based, at least in part, on a user profile” (pages 9-10). The Examiner refers the Applicant to the response to this argument in paragraph 7a above which shows that Donohue does disclose this feature.

f. The Applicant argues in reference to Claims 9, 23, 28, and 37 that there is no motivation to combine the references (page 13). The Examiner notes that all three references disclose a system and method for delivering a publication to a user and are, thus, analogous art. Donohue further discloses how to select the plurality of content

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objects used to make up a customized publication, and the other two references further disclose how to track the distribution, receipt, and disposition of a publication. In all three references and in the Applicant's invention, once the publication has been composed (from the selected plurality of content objects), the entire publication is delivered to the user. Therefore, when attempting to set up a system and method for delivering a customized publication to a user, one of ordinary skill in the art at the time the invention was made would have looked to other publication systems such as disclosed by the cited references and to incorporate the desired features into their system.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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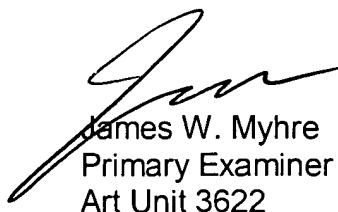
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
June 8, 2004



James W. Myhre
Primary Examiner
Art Unit 3622